

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

U.S. Patent No. : 5,924,578
Application No. : 08/811,772
Inventor : McKenzie; Martha
Filed : March 7, 1997
Issued : July 20, 1999
Docket No. : MCK-1

Title : CLOTHING HANGER HOLDER

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

**REQUEST FOR RECONSIDERATION OF DECISION ON PETITION TO
ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE**

Sir:

Patentee Martha McKenzie respectfully requests that the delayed maintenance fee be accepted in the above-identified patent based on the following:

- 1) Remarks appear on page 2 of this document; and
- 2) A Declaration of Robert L. Epstein accompanies this document along with Exhibit A, the Declaration of Mary Volpe, and Exhibit B, a screenshot of the docket entry for the above-captioned patent.

REMARKS

I. Introduction

Patentee filed a Petition To Accept Unavoidably Delayed Payment Of Maintenance Fee on April 29, 2011. A Decision on Petition was mailed by the USPTO on August 26, 2011 dismissing the petition. Patentee was given two months in which to file a request for reconsideration of the decision. Patentee herewith files a Request for Reconsideration of the Decision on Petition, supported by the accompanying Declarations and Exhibit, and respectfully requests that upon reconsideration the Petition be granted.

II. Discussion

The firm of James & Franklin P.C. (hereinafter "James & Franklin") applied on behalf of, and obtained for, Martha McKenzie U.S. Patent No. 5,924,578, which issued on July 20, 1999 (the "578 patent"). After issuance, and payment of the first maintenance fee on January 9, 2003, James & Franklin merged in March of 2004 with the firm of Bazerman & Drangel P.C. (hereinafter "Bazerman & Drangel") to form the new firm of Epstein Drangel Bazerman & James LLP (hereinafter "Epstein Drangel Bazerman & James"), and concurrently moved into the offices of Bazerman & Drangel. Epstein Drangel Bazerman & James was recently renamed Epstein Drangel LLP (hereinafter "Epstein Drangel").

Prior to the merger, Bazerman & Drangel had an electronic docketing system that operated as follows. The electronic docketing system allows entry into fillable fields of certain data regarding issued patents and patent applications, including docket number, filing date, office action date, and response due date. The electronic docketing system has additional fields that are automatically populated with data based on the data entered in the fillable fields. For instance, when a patent's issuance date is entered in the system, the system automatically calculates and populates the fields indicating the due dates for payment of the first, second, and third maintenance fees. The electronic docketing system automatically generates reminders in the form of emails to firm partners and paralegals indicating upcoming due dates for office actions, issue fee payments, maintenance fee due dates, and other due dates generated by the electronic docketing system.

As part of the merger of James & Franklin and Bazerman & Drangel, the information pertaining to the patent files of James & Franklin, which had formerly been docketed in a manual docketing system that consisted of handwritten three by five index cards, had to be entered into the electronic docketing system used by Bazerman & Drangel. In order to accomplish that task, the partners of the merged firm of Epstein Drangel Bazerman & James, including Robert L. Epstein, devised a protocol for entering the information from each file into the electronic docketing system. A written description detailing the

protocol was prepared and distributed to all members of the clerical team tasked with performing migration to the electronic docketing system. A training session was held in which each step of the protocol was described to each member of the clerical team by one or more of the partners. The members of the clerical team were tested for proficiency at implementing the procedure (*see* Declaration of Robert L. Epstein).

Mary Volpe, one of the members of the clerical team, was assigned the task of entering data from the James & Franklin patent files into the electronic docketing system, including the files for James & Franklin's client Martha McKenzie (*see* Exhibit A to Declaration of Robert L. Epstein; Declaration of Mary Volpe). Ms. McKenzie's patent files with James & Franklin included a file for the '578 patent. Spot checks were performed by the undersigned and the other partners on several of the patent files entered by Ms. Volpe following the data entry process to ascertain whether the protocol was understood and the data was being entered accurately. No errors were detected (*see* Declaration of Robert L. Epstein).

A review of the electronic docketing system of Epstein Drangel revealed that the issuance date for the '578 patent was entered in the electronic docketing system incorrectly. Specifically, the issuance date for the '578 patent was entered as July 20, 1989, instead of the correct date of July 20, 1999 (*see* Exhibit B to Declaration of Robert L. Epstein; screenshot of docket report). The

electronic docketing system is designed to allow an operator to manually enter the issuance date for each issued patent. The system then automatically calculates, based on the issuance date entered, the final due date for each of the three maintenance fee payments and docketed them. (see Declaration of Robert L. Epstein, paragraph 10). In the case of the '578 patent, the electronic docketing system automatically generated all three maintenance fee due dates based on the incorrectly entered issuance date of July 20, 1989, namely January 20, 1993, January 20, 1997, and January 20, 2001 (see Exhibit B to Declaration of Robert L. Epstein).

Based on the incorrect maintenance fee due dates, the system indicated that no maintenance fee payments for the '578 patent were due in the future. Since the system indicated that no future maintenance fees were due on the '578 patent, Ms. Volpe, based on the protocol and training provided, placed the file in the stack of files for which no actions in the future were due, and therefore no changes of correspondence address would be filed (see Declaration of Mary Volpe, paragraph 4). Since there was no reason to maintain the '578 patent file on site after this point in time, the '578 patent file was sent to the firm's off-site storage facility. Once the data entry error had been made, the non-payment of the second maintenance fee on the '578 patent automatically followed, and was therefore unavoidable.

The electronic docketing system could not generate a second maintenance fee due date occurring after the firm merger in 2004 for the '578 patent due to the data entry error. Therefore, the electronic docketing system could not generate any correct maintenance fee due date reminders for the '578 patent, and no one at the firm received an electronic reminder that the second maintenance fee for this patent was due in January of 2007. Since the correspondence address for the '578 patent had not been updated with the USPTO to reflect the changed address and name of the new firm because of the docketing error, even if the USPTO sent the Maintenance Fee Reminder to the old address for James & Franklin, it would not have been received. As a consequence of this data entry error, the second maintenance fee for the '578 patent, which was due at the latest on July 20, 2007, was not paid, which was an unavoidable result based on the data entry error.

The '578 patent file was destroyed, based on the incorrect issuance date entered into the electronic docketing system, pursuant to the firm's policy of periodic purges of expired patent files.

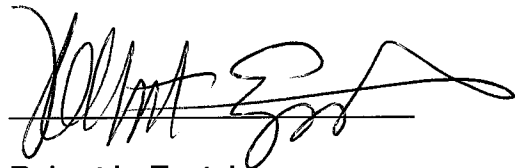
Epstein Drangel learned that the '578 patent had become abandoned after reviewing Public PAIR while preparing a new patent application for Ms. McKenzie on subject matter related to that of the '578 patent. We immediately prepared and filed the original Petition To Accept Unavoidably Delayed Payment Of Maintenance Fee In An Expired Patent.

III. Conclusion

For the reasons discussed above, Patentee respectfully requests reconsideration and grant of the Petition To Accept Unavoidably Delayed Payment Of Maintenance Fee. However, if for any reason the Petitions Attorney should consider this Request to be incomplete, the Petitions Attorney is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a Decision.

Please charge any fee due with this request, including but not limited to the second and third maintenance fees due on the patent, to Deposit Account No. 50-2978.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert L. Epstein', written over a horizontal line.

Robert L. Epstein
Reg. No. 26451
Attorney for Patentee
Tel.: 212-292-5390

Customer Number: 25881
Date: September 21, 2011

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

U.S. Patent No. : 5,924,578
Application No. : 08/811,772
Inventor : McKenzie; Martha
Filed : March 7, 1997
Issued : July 20, 1999
Docket No. : MCK-1

Title : CLOTHING HANGER HOLDER

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

**DECLARATION OF ROBERT L. EPSTEIN IN SUPPORT OF REQUEST FOR
RECONSIDERATION OF DECISION ON PETITION TO ACCEPT
UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE**

I, Robert L. Epstein, declare and state the following:

BIOGRAPHY

[1] I have practiced law for forty years in the field of intellectual property, including patents. I was admitted to practice before the United States Patent and Trademark Office in 1973. Since that time, I have drafted and prosecuted hundreds of U.S. and foreign patent applications in many different technical fields.

[2] I also have extensive experience in litigating patent matters in the Federal Courts. I was admitted to practice in the courts of the State of New York in 1972, in the U.S. District Courts for the Southern and Eastern Districts of New York in 1973, in the U.S. Court of Appeals for the Second Circuit in 1975, in the U.S. Court of Appeals for the Federal Circuit in 1982, and in the United States Supreme Court in 1972. I am currently a member in good standing of the bar of each of the aforementioned courts.

[3] I hold a Bachelor of Science from the Columbia University School of Engineering (1967) and a Juris Doctor from Brooklyn Law School (1971).

THE PROCESS

[4] The firm of James & Franklin P.C. (hereinafter “James & Franklin”) applied for and obtained for Martha McKenzie U.S. Patent No. 5,924,578 (hereinafter “the ‘578 patent”), which patent issued on July 20, 1999. After the issuance, and the payment of the first maintenance fee on January 9, 2003 for the ‘578 patent, James & Franklin merged in 2004 with the firm of

Bazerman & Drangel P.C. (hereinafter "Bazerman & Drangel") to form the firm of Epstein Drangel Bazerman & James LLP (hereinafter "Epstein Drangel Bazerman & James"), and concurrently moved into Bazerman & Drangel's offices. Epstein Drangel Bazerman & James was recently renamed Epstein Drangel LLP (hereinafter "Epstein Drangel").

[5] As part of the merger, the data from the patent files of James & Franklin, which had formerly been docketed in a manual docketing system, was entered into the electronic docketing system used by Bazerman & Drangel prior to the merger. In doing so, the old manual docketing system, which consisted of handwritten three by five index cards indicating the matter and a list of prospective due dates that were placed in a file in date order based on the first prospective due date on the list, was not used as a source for the data for the electronic docketing system. Instead, each of the patent files of James & Franklin was reviewed and the data extracted therefrom. That data was then entered into the electronic docketing system by our staff. The partners of the new firm of Epstein Drangel Bazerman & James considered the files to be the preferred basis for the information entered into the electronic docketing system

because the files themselves were the source of the information in the index card docketing system previously used by James & Franklin, and the due dates in that docketing system were based on the information contained in the files.

[6] The electronic docketing system used by Bazerman & Drangel allows entry into fillable fields of certain data regarding issued patents and patent applications, including docket number, application number, filing date, office action date, and response due date. The electronic docketing system has additional fields that are automatically populated with data based on the data entered in the fillable fields. For instance, when a patent's issuance date is entered in the system, the system automatically calculates and populates the fields indicating the due dates for payment of the first, second, and third maintenance fees. The electronic docketing system generates reminders in the form of emails to firm partners and paralegals indicating upcoming due dates for office actions, issue fee payments, maintenance fee due dates, and other due dates generated by the electronic docketing system.

[7] The partners of the new firm of Epstein Drangel Bazerman & James devised a process for entering the information from each patent file into the electronic docketing system. That process involved a series of steps including:

- assigning a new docket number to each file by the firm's senior administrator, Mimi Claudio-Abad;
- distributing the files to the clerks, including my assistant Mary Volpe, who had successfully completed the training (*see* paragraph 10, below) for data entry; and
- reviewing each file and entering the new docket number and specified data from the file jacket directly into the electronic docketing system.

[8] The information extracted from each file included, for all cases:

- the title of the patent or patent application;
- the serial number of the application;
- the filing date;

- the patent number and issuance date, if issued;
- the names of the inventor(s);
- the client name;
- the assignee, if different from the client; and
- the priority date if any.

[9] After entering the data into the electronic docketing system, a change of correspondence address was to be filed for all pending applications, and for all issued patents having maintenance fee payments due in the future. No correspondence address change was deemed necessary or filed in cases of patents having all maintenance fee payments paid, including expired patents.

[10] For pending applications, if any office action was outstanding, the date of issuance of the office action was to be entered, and the system would then automatically calculate the first (three month) due date and the final (six month) due date, and docket them. If no action was outstanding in a pending application, a one-year status check date was to be manually docketed by the clerk. For issued patents, the issuance date was to be entered in the system.

The system would then automatically calculate, based on the entered issuance date, the final due date for each of the three maintenance fee payments and docket them.

[11] A written description detailing the protocol described above was prepared and distributed to each of the members of the clerical team tasked with performing migration of the information to the electronic docketing system. A training session was held in which each step of the protocol was described to each of the members of the clerical team by one or more of the partners. During this training, the clerks were encouraged to participate and ask any questions that they had regarding the protocol. The training also included supervised entry by each of the clerks of data from several file jackets, including for at least two patent applications and at least two issued patents. This data entry operation was observed by me, and the clerks were encouraged to ask me any questions they had regarding the protocol during this practice session. If I was not entirely satisfied with the performance of the clerk, I continued the training until the clerk performed the data entry task to my satisfaction.

[12] Subsequent to the training session, and periodically during the data entry process, I performed spot checks on the entered data from several of the files worked on by each of the clerks. I did not discover any errors.

[13] At the time of the merger, more than two hundred patent files of James & Franklin, including applications, issued patents and expired patents, were entered into the electronic docketing system by my assistant Mary Volpe. Concurrently, all of James & Franklin's more than one thousand trademark files were reviewed and entered into a separate but related electronic docketing system. Additionally, Bazerman & Drangel had more than two hundred patent files docketed in another electronic docketing system. The data from those files was also entered in the electronic docketing system by the clerks at the time of the merger.

DETAIL OF THE ERROR

[14] Mary Volpe is my assistant at Epstein Drangel. She had been my assistant at James & Franklin for over 20 years at the time of the firm merger.

Ms. Volpe's responsibilities at James & Franklin included maintenance of files and keeping the docket, along with other patent prosecution related tasks, including filing of amendments and applications, and payment of maintenance fees to the USPTO.

[15] Ms. Volpe was part of the clerical team tasked with entering data from patent files into the electronic docketing system. As such, Ms. Volpe received the written protocol for the transfer, attended the training session, and performed several supervised data entry operations under my direct supervision. After performing the supervised data entry operations correctly, Ms. Volpe proceeded to enter the data from the James & Franklin patent files, including the file for James & Franklin's client Martha McKenzie (see Exhibit A; Declaration of Mary Volpe). Ms. McKenzie's patent files with James & Franklin included a file for the application on which U.S. Patent No. 5,924,578 is based, which patent issued on July 20, 1999 (the '578 patent).

[16] I identified that the '578 patent became abandoned after reviewing Public PAIR while preparing a new patent application for Ms. McKenzie

encompassing subject matter related to that of the '578 patent. I immediately prepared and filed the original Petition To Accept Unavoidably Delayed Payment Of Maintenance Fee In An Expired Patent.

[17] A review of the electronic docketing system of Epstein Drangel revealed that the issuance date for the '578 patent had been entered in the electronic docketing system incorrectly. The issuance date for the '578 patent was entered incorrectly as July 20, 1989, instead of the correct date of July 20, 1999 (see Exhibit B; screenshot of docket report for the '578 patent). This error was a data entry error, apparently due either to Ms. Volpe misreading the issue date from the file jacket, or possibly to a keystroke error caused by accidentally hitting the "8" key instead of the "9" key immediately adjacent thereto. As noted above in paragraph 10, the electronic docketing system automatically generated maintenance fee due dates based on the incorrectly entered issue year of 1989, and therefore all of the incorrect maintenance fee due dates had already passed at the time of this docketing error. Since it appeared that no maintenance fees were due on this issued patent, Ms. Volpe, based on the protocol and training provided to her, placed the file in the stack of files for

which no changes of correspondence address would be filed. Since there was no reason to maintain the file on-site after this point in time, the '578 patent file was sent to the firm's off-site storage facility. Once the data entry error had been made, and since there was no way to detect that the error had been made, the non-payment of the second maintenance fee was unavoidable.

CONSEQUENCES OF THE ERROR

[18] Periodic purges of the stored files pertaining to expired patents are conducted by Epstein Drangel personnel. Based on the incorrect issuance date of July 20, 1989, the '578 patent would have appeared to have expired on July 20, 2006. At some time after that date, the '578 patent file was apparently destroyed.

[19] As discussed above, the electronic docketing system could not generate a second maintenance fee due date occurring after the firm merger in 2004 for the '578 patent due to the data entry error. Therefore, the electronic docketing system could not generate any correct maintenance fee due date reminders for the '578 patent, and no one at the firm received an electronic

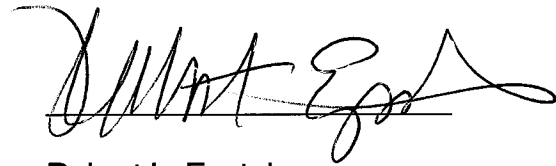
reminder that the second maintenance fee for this patent was due. Since the correspondence address for the '578 patent was not updated with the USPTO to reflect the changed address and name of the new firm because of the docketing error, even if the USPTO had sent the Maintenance Fee Reminder to the old address for James & Franklin, it would not have been received. As a consequence of this data entry error, the second maintenance fee, which was due at the latest on July 20, 2007, was not paid, which was an unavoidable result based on the data entry error.

[20] I identified that the '578 patent became abandoned as a result of a review of Public PAIR while preparing a new patent application on related subject matter for the client. I immediately prepared and filed this petition. With the assistance of my staff, I subsequently reviewed the application data in public PAIR for every patent having a correspondence address of James & Franklin and issued after 1992, since patents issued prior to that date would not have had any maintenance fees due after the firm merger in 2004. My review indicated that no other patents satisfied these criteria except those that were

intentionally abandoned, and therefore the non-payment of the maintenance fee in this case is an isolated error.

I declare under penalty of perjury that the foregoing is true and correct, and I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both, pursuant to 18 U.S.C. § 1001, and may jeopardize the validity of the and may jeopardize the validity of the patent at issue. All statements made herein of my own knowledge are true and that all statements made herein on information and belief are believed to be true.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert L. Epstein", written over a horizontal line.

Robert L. Epstein
Reg. No. 26451

Tel.: 212-292-5390

Date: September 21, 2011

EXHIBIT A

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

U.S. Patent No. : 5,924,578
Application No. : 08/811,772
Inventor : McKenzie; Martha
Filed : March 7, 1997
Issued : July 20, 1999
Docket No. : MCK-1

Title : CLOTHING HANGER HOLDER

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

**DECLARATION OF MARY VOLPE IN SUPPORT OF REQUEST FOR
RECONSIDERATION OF DECISION ON PETITION TO ACCEPT
UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE**

I, Mary Volpe, declare and state the following:

[1] I am an assistant at Epstein Drangel, and had been an assistant at James & Franklin for over 20 years at the time of that firm's merger with Bazerman & Drangel in March of 2004. At James & Franklin, my duties included maintaining files, updating the manual docket, preparing filings for the USPTO, and paying maintenance fees to the USPTO.

[2] I was tasked with entering the data from the James & Franklin patent files into the electronic docketing system of Bazerman & Drangel. I received a written document setting forth the various steps for the entry of data into the electronic docketing system.

[3] I attended a training session for the data entry procedure and performed several supervised data entry operations under the direct supervision of Robert Epstein. My supervised data entry operations included at least two patent application files and at least two issued patent files.

[4] After completing the training, I received the patent files after they had been assigned a new docket number. In accordance with the written document and the training, I reviewed the file jacket for pertinent information and entered that data into the electronic docketing system. This information included the title of the patent or patent application, the serial number of the application, the filing date, the patent number and issuance date, if issued, the names of the inventor(s), the client name, the assignee, if different from the client, and the priority date, if any.

[5] For pending patent applications, if any action was outstanding, I entered the date of issuance of the action, and the electronic docketing system automatically calculated the three month and six month due dates. If no action was outstanding in a pending application, I manually entered a one-year status check date. For issued patents, I entered the issuance date for the patent, and the electronic docketing system automatically calculated the three year and six month, the seven year and six month, and the eleven year and six month maintenance fee due dates.

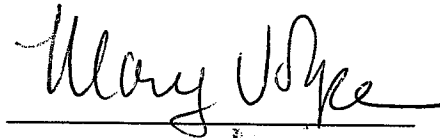
[6] After entering the data, I reviewed the due dates automatically generated by the electronic docketing system or entered manually by me (in the case of a status check). If the case had any future action dates, I placed the file in a stack designated to have a correspondence address change filed. If the case had no future action dates, I placed the file in a stack designated to be sent to an off-site storage facility, without the filing of a change of correspondence address.

[7] I completed the data entry into the electronic docketing system of all James & Franklin's patent files, including the files for Martha McKenzie. Ms.

McKenzie's patent files with James & Franklin included a file for U.S. Patent No. 5,924,578, which issued on July 20, 1999.

I declare under penalty of perjury that the foregoing is true and correct, and I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both, pursuant to 18 U.S.C. § 1001, and may jeopardize the validity of the and may jeopardize the validity of the patent at issue. All statements made herein of my own knowledge are true and that all statements made herein on information and belief are believed to be true.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Mary Volpe", is written over a horizontal line.

Mary Volpe

Tel.: 212-292-5390

Date: September 21, 2011

EXHIBIT B

PATENTS

| | |
|-------------------------------------|--|
| Owner: | McKenzie, Martha |
| Correspondent: | McKenzie, Martha |
| Matter number: | MCK-1 |
| Assignment recorded: | <input type="radio"/> Yes <input checked="" type="radio"/> No |
| Application Type: | <input type="radio"/> Provisional <input checked="" type="radio"/> Non-Provisional <input type="radio"/> Continuation <input type="radio"/> C-I-P <input type="radio"/> National Stage Entry <input type="radio"/> PCT <input type="radio"/> Foreign <input type="radio"/> Design <input type="radio"/> CTM Design |
| Application number: | 08/811,772 |
| Filing date: | 3/7/1997 |
| Filing Fee paid: | 0 |
| Title: | CLOTHING HANGER HOLDER |
| First named inventor: | Martha McKenzie |
| Group art unit: | |
| Examiner name: | |
| Attorney docket number: | 3059-100 |
| IDS Date Due: | 1/1/1900 |
| IDS Filed Date: | 1/1/1900 |
| Notice of missing parts due date: | |
| Notice of missing parts filed date: | |
| Priority application number: | |
| Priority country: | USA |
| Priority date: | 3/7/1997 |

| | |
|--|---|
| Priority date: | 3/7/1997 |
| Certified copy of foreign application filed: | <input type="radio"/> Yes <input checked="" type="radio"/> No |
| Last day for foreign filing: | 3/7/1998 |
| PCT application number: | |
| Office action: | |
| Response Due Date: | |
| Notice of appeal: | |
| Appeal brief due: | |
| Assignment recorded on reel frame: | |
| Date of assignment recordal: | |
| Projected publication date: | 8/29/1998 |
| Requested early publication: | <input type="radio"/> Yes <input checked="" type="radio"/> No |
| Early publication fee paid: | 0 |
| Notice of allowance: | |
| Issue fee due date: | |
| Issued date: | 7/20/1989 |
| Patent number: | 5924578 |
| First maintenance fee due: | 1/20/1993 |
| Second maintenance fee due: | 1/20/1997 |
| Third maintenance fee due: | 1/20/2001 |
| Check Status Date: | |
| Check Status Notes: | UTILITY - GRANTED: |